

## **REMARKS**

### **The Amendments**

The claims are amended to clarify that the flame retardant and plasticizer are distinct components. This was evident from the disclosure as a whole and, thus, is clearly supported. The amendments do not narrow the scope of the claims since they merely clarify what was already inherent from the disclosure. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application. Additionally, further dependent claims are added.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

### **The Rejection under 35 U.S.C. §112, second paragraph**

The rejection of claims 12-31 under 35 U.S.C. §112, second paragraph, is believed to be rendered moot by the clarifying amendment to each of the independent claims. The claims now explicitly state that the plasticizer component is different from the flame retardant component. It is also urged that the distinction is also made by the recited function of each component. The "phosphorus-containing plasticizer" component of the claims is only met if the component provides a plasticizing function and the "fire retardant" component is only met

if the component provides a fire retardant function. It is noted that the particular examples of the phosphorus-containing plasticizer and fire retardant in applicants' disclosure do not overlap with each other. In any event, the claims now make clear that the claims are only met when these two components are distinct components, thus, the rejection is believed to be overcome.

### **The Rejection under 35 U.S.C. §103**

The rejection of claims 12-14, 19, 22, 27 and 30 under 35 U.S.C. §103, as being obvious over Kato (U.S. Patent No. 6,605,655) is respectfully traversed.

Kato discloses polyamide resin compositions having a polyamide resin, a phyllosilicate component and an olefin compound. The primary characterizing feature of the invention is the use of a phyllosilicate modified with a functional group. Kato also discloses the optional inclusion of any of a number of additives, including, amongst others, fire retardants and fillers. Kato discloses a large number of possible fire retardants, including, particularly, halogen-containing, phosphorus and triazine fire retardants; see, e.g., col. 9, line 31, to col. 12, line 62. Kato also discloses a large number of possible fillers; see, e.g., col. 6, line 57, to col. 7, line 16.

Applicants respectfully submit that the claimed invention is not obvious from Kato because the reference fails to disclose or suggest a composition which contains a phosphorus-containing plasticizer component and, even if Kato does disclose or suggest such a component, Kato fails to fairly suggest picking and choosing from amongst its disclosure in a manner which would suggest applicants' particular combination of components.

Kato makes no mention of the use of a plasticizer in its compositions. The Office Action points to the disclosure of the use aromatic phosphates and biphenophosphates in Kato (col.

9, lines 60-67) as apparently suggesting this element of applicants' invention. Yet, this disclosure in Kato relates to fire retardant components. There is no disclosure or suggestion whatsoever in Kato that such components would provide a plasticizing effect or that one of ordinary skill in the art should select a fire retardant which provides a plasticizing effect. The instant claims require that the phosphorus-containing plasticizer provide a plasticizing effect and there is no suggestion from Kato to provide a fire retardant or any other component which provides a plasticizing effect. In this respect, it is further noted that the claims now provide for a plasticizer "which is different from the fire retardant."

Furthermore, even if the particular phosphate flame retardants of Kato did meet the requirements of applicants' plasticizer, the combination of components recited in the instant claims would still not be met. In order to meet the elements of the instant claims, one of ordinary skill in the art would have to do a great deal of picking and choosing of very specific embodiments from the generic teachings of Kato and make a very specific combination of such selected embodiments. Kato gives no direction to one of ordinary skill in the art to make all of the selections that would be necessary to arrive at applicants' invention. Even if selection of such components could be said to be generically possible within Kato, such broad generic inclusion does not necessarily support a finding of obviousness. As was clearly set forth in In re Jones, 21 USPQ 2d 1941 (Fed. Cir. 1992), it is not the law that "regardless of how broad, a disclosure of a chemical genus renders obvious any species which happens to fall within it." Instead, the disclosure must be considered as a whole as to whether it fairly suggests the claimed invention to one of ordinary skill in the art. See also, In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994), further clarifying that when the reference directs one of ordinary skill in the art to preferring one embodiment over another this is a factor in determining what is fairly suggested.

In the instant case, to arrive at applicants' invention from Kato, one of ordinary skill in the art would have to be motivated to make the following selections and combinations. First, since a flame retardant is merely optional, they would have to select to include a flame retardant. Second, they would have to select to not use the halogen-containing flame retardants which are the first preferred type of flame retardant taught by Kato. Third, they would have to select to use an additional flame retardant. Fourth, they would have to select as the additional flame retardant a phosphorus-containing flame retardant from among the several types disclosed by Kato. Fifth, they would have to select a particular type of phosphorus-containing flame retardant which also provides a plasticizing effect, even though Kato discloses a number of inorganic phosphorus compounds as the most preferred phosphorus flame retardants, more preferably over the aromatic phosphates, for which no more specific description is given. Sixth, they would have to select to use a filler since fillers are merely optional in Kato. And seventh, they would have to select the particular zeolite filler out of the long list of possible fillers described by Kato. Finally, they would have to combine these components in amounts to meet the claim requirements. Contrary to pointing one of ordinary skill in the art towards making each of these particular selections and combinations, Kato actually directs one of ordinary skill in the art to other more preferred embodiments which would direct away from such selections and combinations. For example, Kato indicates a preference for fillers which does not include zeolites; see col. 7, lines 14-16. Kato also indicates a first preference for halogen-containing fire retardants. Further, when phosphorus fire retardants are to be used, Kato indicates a preference to red phosphorus, an inorganic form of phosphorus which would not be a plasticizer. Applicants contend that although Kato does not actually direct away from any individual non-preferred embodiment, it does not fairly suggest to one of ordinary skill in the art an embodiment of their invention

which is a combination of multiple selections of non-preferred embodiments. Applicants' position is in line with the case law of In re Baird, *supra*, wherein the art had a broad generic teaching with multiple selections possible and the reference, contrary to pointing one of ordinary skill in the art towards selections which would result in the claimed invention, pointed one of ordinary skill in the art towards other embodiments which did not suggest the claimed invention. As in Baird, it is urged that the instant facts do not support a finding of obviousness.

For all of the above reasons, it is urged that Kato fails to render the claimed invention obvious to one of ordinary skill in the art and thus the rejection under 35 U.S.C. §103 should be withdrawn.

Additional reasons for nonobviousness apply to claims 15-18, 20-21, 23-26, 28-29 and 31, as recognized in the Office Action by the fact that these claims were not subject to the 35 U.S.C. §103 rejection.

Further, additional reasons for nonobviousness apply to certain of the newly added dependent claims. Claims 38-40 recite compositions which "consist essentially of" the recited components. The phyllosilicate component required in Kato is not one of the components required in the claimed invention. The phyllosilicate component of Kato is essential to its compositions and clearly materially changes the properties of such compositions, as discussed by Kato. Kato would not suggest compositions which are absent the phyllosilicate component and, thus, would not render obvious claims 38-40. Claim 41 specifically excludes a phyllosilicate component and thus it clearly would also not be rendered obvious by Kato. For these additional reasons, the 35 U.S.C. §103 rejection should not be applied to these claims either. Although, based on the arguments made above, it is

believed the Kato does not render obvious the independent claims, so these additional points are not necessary to a finding of allowability.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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